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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,362	07/28/2000	Thorsten Melcher	019488-000710US	3565

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EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,362

Applicant(s)

MELCHER ET AL.

Examiner

Frank W. Lu

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1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's response to the office action filed on January 28, 2002 has been entered and a petition for a withdrawal of the holding of abandonment has been approved on March 24, 2003. The claims pending in this application are claims 1-21. All rejections from the previous office action made by previous examiner are hereby withdrawn.

Election/Restrictions

2. In view of claims 1-21, the examiner notes that restriction to one of the following inventions is required under 35 U.S.C. 121 and has not been made by previous examiner:

I. Claims 1-5, drawn to a method of identifying redundant clones in a cDNA library (claims 1-4) and a method of identifying previously characterized clones in a cDNA library (claim 5), classified in class 435, subclass 287.2.

II. Claims 6-14, drawn to an improved method of making a normalized or substracted cDNA library, classified in class 436, subclass 94.

III. Claims 15-20, drawn to a method for selecting clones for analysis, classified in class 435, subclass 6.

IV. Claim 21, drawn to a method for comparing the quality of two different cDNA libraries, classified in class 435, subclass 287.2.

3. The inventions are distinct, each from the other because of the following reasons:

Groups I and II are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will

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have to be performed. For example, the search required for Group I such as step c) of claim 1 is not required for Group II while the search required for Group II such as step c) of claim 6 is not required for Group I.

Groups I and III are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group I such as step c) of claim 1 is not required for Group III while the search required for Group III such as step e) of claim 15 is not required for Group I.

Groups I and IV are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group I such as step d) of claim 1 is not required for Group IV while the search required for Group IV such as step e) of claim 21 is not required for Group I.

Groups II and III are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group II such as step c) of claim 6 is not required for Group III while the search required for Group III such as step e) of claim 15 is not required for Group II.

Groups II and IV are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group II such as step c) of claim 6 is

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not required for Group IV while the search required for Group IV such as step e) of claim 21 is not required for Group II.

Groups III and IV are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group III such as step e) of claim 15 is not required for Group IV while the search required for Group IV such as step e) of claim 21 is not required for Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
July 6, 2005


FRANK LU
PATENT EXAMINER